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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,743	09/30/2004	Kazuo Miyazawa	0038-0447PUS1	4365

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EXAMINER

NGUYEN, PHONG H

ART UNIT	PAPER NUMBER
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3724

NOTIFICATION DATE	DELIVERY MODE
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06/18/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/509,743

Applicant(s)

MIYAZAWA ET AL.

Examiner

Phong H. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-10,12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/30/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1, 3, 5-10, 12 and 14-18 in the reply filed on 05/24/2007 is acknowledged. The traversal is on the ground(s) that all the claims are linked so as to form a single general inventive concept as shown in the International search report and this application has a reasonable number of species. Therefore, all the claims should be examined. This is not found persuasive because the International search report provided by the Applicant does not cover all aspects of the two inventions. In order to thoroughly examining only one invention, the Examiner needs to perform search in many classes and subclasses. Therefore, examining two inventions at the same time creates a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5-7, 10, 12 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by McCormick.

Regarding claims 1 and 10, McCormick teaches a method for manufacturing a tissue section comprising the steps of:

- adjusting a distance between a slicing surface of a specimen 14 and one side of a film 24 by means 34;
- adjusting a temperature difference between the specimen and the film (the temperature of oil 22 is adjustable. Therefore the temperatures of the specimen and the film are adjustable); and
- running the film 24 at a speed in synchronism with a slicing speed of the tissue section.

Regarding claims 3 and 12, the oily environment 22 adjusts the temperature of the film 24 for picking up a tissue 26.

Regarding claims 5, 6, 14 and 15, a plurality of rollers (44, 40a and 48) is best seen in Fig. 1. A close roller 40 is best seen in Fig. 1.

Regarding claim 7, running the film 24 at a speed in synchronism with a slicing speed of the tissue section is best seen in Fig. 1.

Regarding claim 16, the running film speed and the slicing speed are controllable.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick.

McCormick teaches a ratio of the running film speed and the slicing speed but does not teach a specific value of the ratio of 1.2-0.8. It would have been obvious to one skilled in the art to provide a ratio of 1.2-0.8 since it relates to repeated experimental processes but not an inventive concept.

6. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Ullberg (3,690,988).

McCormick teaches the invention substantially as claimed except for a transparent film.

Ullberg teaches using a transparent film for conveying tissues. See col. 4, lines 50-55. Therefore, it would have been obvious to one skilled in the art to use a transparent film as taught by Ullberg in the microtome machine of McCormick for better viewing tissues.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pickett teaches a microtome machine of general interest.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy V. Eley/
Primary Examiner, A.U. 3724

PN: 

June 9, 2007